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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91209617
Party	Defendant Debra Wiseberg
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Submission	Other Motions/Papers
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Signature	/Debra Wiseberg/
Date	02/19/2015
Attachments	Applicant's Motion for Reconsideration of Decision on Motion.pdf(1064653 bytes ) Brief in Support of Motion for Reconsideration.pdf(5060830 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Xikar, Inc.,	1	
	§	
	§	
	§	
Opposer,	§	Opposition No. 91209617
	§	
v.	§	Mark: Cicar
	§	
Debra Wiseberg d/b/a	§	Serial No. 85/652496
Bram Warren Company,	§	
	§	
Applicant.	§	
	↓	

APPLICANT AND COUNTERCLAIM PLAINTIFF'S  
MOTION FOR RECONSIDERATION OF DECISION ON MOTION  
(DISMISSAL OF FRAUD CLAIM)  
AND REQUEST TO SUSPEND PROCEEDINGS

COMES NOW, Debra Wiseberg, Applicant and Counterclaim Plaintiff, (hereafter "Applicant" or "Counterclaim Plaintiff") in this action pursuant to 37 CFR § 2.127(b); TBMP § 518; and TBMP § 503.03, to request that the Board reconsider their decision dated January 20, 2015 to dismiss the Applicant's fraud claim against Xikar, Inc., a Kansas corporation, Opposer and Counterclaim Defendant (hereafter "Opposer" or "Counterclaim Defendant") and allow the Applicant to amend the fraud claim to correct the deficiencies the Board found in such pleading. The Applicant has filed this request for reconsideration because the Board was silent in their decision dated January 20, 2015 on whether or not the Applicant could amend the fraud claim. The Counterclaim Plaintiff has put forth a few arguments for the Board to consider regarding the "fraud claim" in response to the Board's decision. The Applicant has concurrently filed a motion for leave to amend the fraud pleading and has attached the proposed amended pleading to such

motion. The Applicant has filed this request for reconsideration as a matter of record, while concurrently filing a motion for leave to amend the fraud pleading and proposed amended (fraud) counterclaim, so the Board may collectively decide the matter.

The Applicant further requests the Board suspend the proceedings to allow for the Applicant's motions to be decided. Additional motions concerning discovery will most likely need to be filed in this matter before the testimony period begins.


Dated: February 19, 2015

Respectfully submitted,

By:   
Debra Wiseberg  
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CERTIFICATE OF FILING

I hereby certify that the Applicant and Counterclaim Plaintiff's Motion for Reconsideration of Decision on Motion (dismissal of fraud claim) and Request to Suspend Proceedings, and Brief in Support of Applicant and Counterclaim Plaintiff's Motion for Reconsideration of Decision on Motion were filed with the United States Patent and Trademark Office, Trademark Trial and Appeal Board by ESTTA on February 19, 2015.

By:   
Debra Wiseberg

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the Applicant and Counterclaim Plaintiff's Motion for Reconsideration of Decision on Motion (dismissal of fraud claim) and Request to

Suspend Proceedings, and Brief in Support of Applicant and Counterclaim Plaintiff's Motion for

Reconsideration of Decision on Motion were sent to the counsel for the Opposer by the United

States Postal Service, first class mail on February 19, 2015 to the following address:

Ginnie C. Derusseau  
Erickson, Kernell, Derusseau & Kleypas LLC  
8900 State Line Road, Suite 500  
Leawood, KS 66206

By:

  
Debra Wiseberg



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	↓	

BRIEF IN SUPPORT OF THE APPLICANT AND COUNTERCLAIM PLAINTIFF'S  
MOTION FOR RECONSIDERATION OF DECISION ON MOTION  
(DISMISSAL OF FRAUD CLAIM)

I. INTRODUCTION

The Applicant and Counterclaim Plaintiff has filed this motion for reconsideration to respectfully request the Board reconsider their decision to dismiss the Applicant's fraud claim against the Opposer and allow the Applicant to amend the fraud claim to correct the deficiencies the Board found in such pleading in their decision dated January 20, 2015. The Board was silent in their decision on whether or not the Applicant could amend the fraud claim, which was only pleaded by the Applicant once. The Applicant pled the fraud claim against the Opposer for the first time within the Applicant's Amended Counterclaim dated August 14, 2014. The Applicant has put forth a few arguments to be considered by the Board in response to their decision regarding the fraud claim. The Counterclaim Plaintiff's generic counterclaim against the Counterclaim Defendant withstood the Opposer's Motion to Dismiss/Strike and has been answered by the Opposer on February 9, 2015. This motion for reconsideration concerns the dismissed fraud claim against the Counterclaim Defendant. The Applicant has filed this request

for reconsideration as a matter of record<sup>1</sup>, while concurrently filing a motion for leave to amend the fraud pleading and the proposed amended counterclaim, so the Board can collectively decide the matter.

## II. ARGUMENTS

The Applicant filed a fraud claim against the Opposer for the first time within the Applicant's Amended Counterclaim filed on August 14, 2014. The Board found in their decision dated January 20, 2015 that the Applicant's fraud claim failed to state a claim upon which relief can be granted. If the Board allows the Applicant to amend the fraud claim against the Opposer, it will be the first amendment filed for such claim. The Applicant has put forth the following arguments regarding the Applicant's fraud claim, in response to the Board's decision regarding such claim.

The Applicant used the terms "knowingly" and "fraudulently" within the allegations contained in the Applicant's Amended Counterclaim filed on August 14, 2014 to signify the Opposer's intent to deceive. In the *In Re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009) decision, the Court of Appeals essentially found that the Board had applied a "should

<sup>1</sup>The Board stated on page 3, foot note 3 of their decision, that the Applicant's standing as a counterclaimant is not at issue. To clarify my arguments, they concerned the interpretation of the written law as it pertains to the false association with persons living or dead and the misrepresentation as to source of goods statutes. The law as written does not specify that in order to bring these claims you must be the person, specific group or class that has been either falsely associated with or whose goods are being misrepresented. My brief argument pertained to a counterclaimant's ability to plead these statutes whether or not they are the person, specific group or class infringed upon. If one's ability to bring these claims or not, are based on the damages incurred by such person, group or class based on such actions and the lack of damages incurred by persons, groups or classes not directly affected by these actions. My argument is that as a counterclaimant you are damaged by the opposing parties actions by the filing of an opposition to register one's intellectual property and such a party should be allowed to bring all grounds contained in the statutes whether or not they are the direct person, group, or class being falsely associated with and/or misrepresented by the other party, as the continued registration of such questionable mark will damage a counterclaimant.



know” analysis instead of “the registrant knows” analysis and such was “inconsistent with the framework set out elsewhere in *Torres*.” *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 48 (Fed Cir 1986). The Court of Appeals stated that, “one should not unduly focus on the phrase “should know” and ignore the facts of the case, i.e., the registrant “knows” and citing *Torres* reiterated the “legal framework the court set out in *Torres*”, “that (1) fraud in trademark cases “occurs when an applicant knowingly makes false, material representations,” (2) the Lanham Act imposes on an applicant the obligation not to “make knowingly inaccurate or knowingly misleading statements,” and (3) a registrant must also “refrain from knowingly making false, material statements.” Also emphasized within the *In Re Bose* decision is the difference between a “false” and “fraudulent” representation, stating “mandated by the statute and caselaw, the Board had consistently and correctly acknowledged that there is “a material legal distinction between a ‘false’ representation and a ‘fraudulent’ one , the latter involving an intent to deceive”. The case that spawned the appeal in *In Re Bose* was *Bose Corp. v. Hexawave, Inc.*, 88 USPQ2d 1332, 1338 (T.T.A.B. 2007), in which the TTAB cancelled the registration for the trademark WAVE in its entirety based on Hexawave’s fraud claim against Bose Corp. The Board’s decision in *Bose Corp. v. Hexawave* was based on the fact that Mark E. Sullivan, general counsel for Bose Corp. executed the Section 8 affidavit and Section 9 renewal application including the registered goods “audio tape recorders and players” on January 8, 2001 when Bose stopped manufacturing and selling “audio tape recorders and players” sometime between 1996 and 1997. Mr. Sullivan testified that he believed that WAVE mark was being “used in commerce” on such goods because Bose continued to repair and transport audio tape recorders and players back to customers. The Board concluded in *Bose Corp. v. Hexawave* that Mr. Sullivan’s belief that transporting repaired goods was unreasonable and a material misrepresentation and ruled that

Bose had committed fraud cancelling the WAVE mark in its entirety. The Court of Appeals found in *In Re Bose* that before Mr. Sullivan made his 2001 declaration that “neither the PTO nor any court had interpreted “use in commerce” to exclude the repairing and shipping repaired goods” so that “even if we were to assume that reckless disregard qualifies, there is no basis for finding Sullivan’s conduct reckless” (due to this the Court of Appeals chose not to resolve the issue of whether or not making a submission to the USPTO with reckless disregard of its truth or falsity satisfies the intent to deceive requirement) and found the Board erred in canceling the WAVE mark in its entirety. The *In Re Bose* decision pertains to the application of a “the registrant knows” standard instead of a “should know” standard; the fact that Bose Corp. essentially did not misrepresent the truth, because the term “use in commerce” had not been defined in 2001 to exclude “the repairing and shipping of goods”; and that no public purpose is served by removing technically good trademarks on the register that are in use, when a trademark registrant fulfills the obligation to refrain from knowingly making material misrepresentations. I would like to emphasize to the Board the Court of Appeals use of the term “technically good trademarks” in the *In Re Bose* decision, for the Applicant hopes to prove that not only was the registration for the “Xikar” trademark obtained and maintained fraudulently, but that it is also not a technically good trademark.

I believed the use of the terms “knowingly” and “fraudulently” within the fraud claim contained in the Applicant’s Amended Counterclaim dated August 14, 2014 was sufficient to signify the Opposer’s intent, since “fraudulent” implies an intent to deceive and “knowingly” implies such intent was with knowledge. Since the Board deemed that such terms are not sufficient to signify the Opposer’s intent, then I respectfully request the Board allow the Applicant to amend the fraud counterclaim against the Opposer. The Board was silent as to



whether or not the Applicant could amend the fraud counterclaim to correct any deficiencies within such pleading. The Applicant requested on page 24 of the Applicant's Opposition Brief to the Opposer's Motion to Dismiss/Strike that "if the Board finds for any reason that the Applicant's Amended Counterclaim and individual claim(s) within are defective in any way, then pursuant to TBMP § 503.03, I would respectfully request the Board allow the Applicant to further amend her counterclaim to correct any such deficiencies within". TBMP § 503.03, states that "if no amended complaint is submitted in response to a motion to dismiss for failure to state a claim upon which relief can be granted, and the Board finds, upon determination of the motion, that the complaint fails to state a claim upon which relief can be granted, the Board generally will allow the plaintiff an opportunity to file an amended pleading." The Applicant has only pled the fraud claim once and an amendment to such claim would be the first. The Applicant has included specific language of intent and has more specifically pled the fraud claim within the Applicant's Second Amended Counterclaim attached to her motion for leave to amend such pleading.

As cited in *In Re Bose*, "because direct evidence of deceptive intent is rarely available, such intent can be inferred from indirect and circumstantial evidence" though such "evidence must be clear and convincing." *Star Scientific, Inc. v. R.J. Reynolds Co.*, 537 F.3d 1357, 1366 (Fed. Cir. 2008). "The more material the omission or misrepresentation, the lower [the] level of intent [is] required to establish inequitable conduct, and vice versa." *Critikon, Inc. v. Becton Dickinson Vascular Access, Inc.*, 120 F.3d 1253, 1256 (Fed. Cir. 1997). The issues in *In Re Bose* vary greatly from the matter now before the Board, the Opposer and their predecessor in interest Kurt Van Keppel knew they were making false, material misrepresentations of fact with the intent to deceive the USPTO. This matter concerns among others (alleged in the Applicant's

Second Amended Counterclaim), the intent of Kurt Van Keppel and the Opposer (TMEP §1202.01) when they filed the registration for the mark “Xikar” in the name of Kurt Van Keppel, an individual and not in the name of Xikar, Inc., a Kansas corporation, when Xikar, Inc. was the party who intended to use the mark in commerce and not Kurt Van Keppel, an individual. When statements of use and transfer were filed by Kurt Van Keppel and the Opposer, differentiating from *Bose* there was no “use of the mark in commerce” by Kurt Van Keppel, an individual. There was no business to transfer between Kurt Van Keppel, an individual and the Opposer and it can’t be said that such false, material misrepresentations of fact were made because of a misunderstanding, because both parties to the Assignment of the “Xikar” mark were well aware that Kurt Van Keppel, an individual never used the mark in commerce and had no business to transfer and therefore had no valid right, title or interest in the registration for said mark, and yet both parties executed an assignment of the mark stating that such had occurred. The Opposer and Kurt Van Keppel transferred the ownership of the mark to the Opposer immediately before the Opposer filed the Declaration of Use and Incontestability under Sections 8 & 15. Kurt Van Keppel and the Opposer were well aware that the registration for the mark “Xikar” was invalid. The Opposer and Kurt Van Keppel manipulated the laws pertaining to the registration of a mark and successfully deceived the USPTO. The Opposer was afforded additional rights and protections because of such deceptive actions that the Opposer is not entitled to.

It is my belief that the Applicant’s fraud claim against the Opposer was sufficiently pled in the Applicant’s Amended Counterclaim filed August 14, 2014, even still, the Applicant has considered the Board’s decision in this matter dated January 20, 2015 and has concurrently filed a motion for leave to amend pleading and a proposed amended fraud counterclaim to include additional language and to more specifically plead such claim. The Board cited in their decision



dated January 20, 2015 that a “complaint must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face.” Ashcroft v. Iqbal, 556 U.S. 662, 129 S.Ct. 1937, 1949-50 (2009), quoting Bell Atlantic Corp. v. Twombly, 550 U.S. 544, 570 (2007). The fraud claim contained in the Applicant’s Amended Counterclaim filed on August 14, 2014 consisted of allegations of fraud and supporting allegations to such fraud claim. The Applicant believed she had given the Opposer sufficient notice of its claims and that such allegations were specific enough to survive the Opposer’s Motion to Dismiss/Strike, and that the use of “knowingly” and “fraudulently” within such allegations was sufficient to signify the Opposer’s intent to deceive, nonetheless, the Applicant has amended such fraud claim.

*Non-Disclosure of Translation of Mark (Material Element)*

The Board stated in their January 20, 2015 decision, that the “lack of disclosure of a translation of a mark is not as a matter of course a material element of filing an application for registration” in foot note 7 on pages 8 and 9 of their decision. The translation of a mark can prevent the registration of a mark if the USPTO deems the mark ineligible for registration due to its translation. The lack of disclosure of a translation of a mark prevents the USPTO from properly scrutinizing the mark during the application process. If the disclosure of a translation of one’s mark is required when a trademark application is filed, then such should be deemed “a material element of filing an application for registration”. “An application to register a mark that includes non-English wording must include an English translation of that wording.” 37 C.F.R. §2.32(a)(9). If a party is aware of a translation of a mark and is required to disclose the Non-English wording when they file their trademark application (TMEP §809) and knowingly does not disclose such information, then the omission of such information is a false, material misrepresentation of fact with the intent to deceive the USPTO.



### III. CONCLUSION AND REQUEST

The Opposer's counsel has continuously made comments within their filings to the Board to malign the Applicant and her arguments. These comments include, but are not limited to, that my arguments are melancholic, specious, emotionally charged, longwinded, ridiculous, irrelevant and a cheap attempt to detract from, and perhaps compensate for its deficient counterclaims (all of these comments are contained in the 1<sup>st</sup> page of the Opposer's Reply filed in support of their Motion to Dismiss/Strike). I think the Opposer and their counsel doth protest too much and with mere words of insult. I strongly dispute all of these comments (and others) and the Opposer is overestimating itself, if they believe I'm inferring that they are Goliath. I have simply stated the facts with no attempt at sympathy. I find it absurd that the Opposer's counsel accused the Applicant of trying to detract from and compensate for "its deficient counterclaims". The Opposer's counsel inappropriately requested additional remedies against the Applicant within their Motion to Dismiss/Strike and the Applicant simply responded to such inappropriate requests and its arguments, and yet, the Opposer accuses the Applicant of trying to detract from the issue at hand. The Applicant hopes the Board is able to read-through such obvious tactics to disparage one's arguments, and the Opposer's various attempts to mislead the Board<sup>2</sup>.

<sup>2</sup>The Board stated in their decision "that, as a general matter, it is troubling and unproductive for any party to be reluctant to discuss settlement or matters necessary to advancing an inter partes proceeding". I wanted to assure the Board that if it was the Applicant of which the Board was troubled, that the Opposer and their counsel have merely painted a false picture to disparage the Applicant to the Board. I can assure the Board that I understand the issues in this matter and that I have not hindered settlement of this matter. The Applicant sent the Opposer's counsel a second counteroffer for settlement on September 29, 2014 of which the Opposer and their counsel were very aware. The Opposer and their counsel had my counteroffer in their hands and yet attempted to convey a scenario to the Board that I was preventing settlement and was incapable of negotiating a settlement of the matter. The Opposer did not respond to my second counteroffer dated September 29, 2014 until February 2, 2015 (4 months, 3 days later), in which they merely re-offered their first settlement proposal dated August 5, 2013 for a second time. The Applicant has since sent the Opposer a third counteroffer, in which the Opposer responded by essentially re-offering their first settlement proposal dated August 5, 2013 for a third time.

The Applicant prays that the Board will allow her to amend the fraud claim against the Opposer, which they deemed was insufficiently pled by the Applicant in the Applicant's Amended Counterclaim dated August 14, 2014. The Applicant requested in her response to the Opposer's motion to dismiss/strike, that if the Board found the Applicant's pleading defective, in any way, that they allow me to amend such pleading (TBMP §503.03). The Board was silent in their decision dated January 20, 2015, as to whether or not the Applicant could amend the fraud counterclaim. The Applicant has only pled the fraud claim once and this is the Applicant's first and only request to amend such claim. The Applicant has amended the fraud claim within the Applicant's proposed Second Amended Counterclaim attached to the Applicant's Motion for Leave to Amend (Fraud) Pleading filed concurrently with this motion. The Applicant has included specific language of intent and has more specifically pled the fraud claim within the aforementioned amendment.

The Applicant respectfully requests the Board reconsider their decision to dismiss the Applicant's fraud claim against the Opposer and allow the Applicant to amend the fraud claim to correct the deficiencies found in the first filing of such claim. The Applicant has filed this motion, while at the same time, filing a motion for leave to amend pleading, and an amended (fraud) counterclaim, to enable the Board to collectively decide the matter. The Applicant further requests that the Board suspend the proceedings until the Applicant's motions have been decided. Additional motions concerning discovery will most likely need to be filed in this matter before the testimony period begins. The Opposer has responded to the Applicant's previous requests for supplementation of their discovery responses by sending supplementation, which essentially supplemented nothing. I have yet to receive a solid response to my last detailed



request dated September 8, 2014, for the Opposer to supplement their discovery responses, as to whether or not the Opposer even intends to supplement such responses.


Dated: February 19, 2015

Respectfully submitted,

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CERTIFICATE OF FILING


I hereby certify that the Applicant and Counterclaim Plaintiff's Motion for Reconsideration of Decision on Motion and Request to Suspend Proceedings, and Brief in Support of Motion were filed with the United States Patent and Trademark Office, Trademark Trial and Appeal Board by ESTTA on February 19, 2015.

By:   
Debra Wiseberg

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the Applicant and Counterclaim Plaintiff's Motion for Reconsideration of Decision on Motion and Request to Suspend Proceedings, and Brief in Support of Motion were sent to the counsel for the Opposer by the United States Postal Service, first class mail on February 19, 2015 to the following address:

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By:   
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